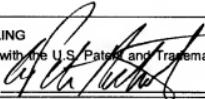


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Date: April 29, 2008 Name: G. Peter Nichols Signature: 

PATENT
Case No. 10225/57 (A28)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Prochazka et al.)
Serial No. 10/712,768) Examiner: Fiorito
Filing Date: November 13, 2003) Group Art Unit No. 1793
For: Process to Make Rutile Pigment) Confirmation No. 7402
From Aqueous Titanium Solutions)

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Appellants submit this Reply Brief in response to the Examiner's Answer mailed April 1, 2008. The Reply Brief is timely filed within two months from the mailing date of the Examiner's Answer.

ARGUMENT

The Examiner's Answer does not compel a conclusion that the appealed claims would have been obvious under 35 U.S.C. § 103(a).

A. The minor quantities of salt disclosed by the prior art does not inherently or otherwise teach the claimed quantity of about 3%

Independent claim 1 requires using an amount of particular catalyzing salts, NaCl, KCl, and LiCl, in an amount from about 3% by weight of the equivalent amount of titanium dioxide to about the amount corresponding to the saturation point of the catalyzing salt in the feed solution. The Examiner acknowledges that the prior art does not expressly state the claimed 3% by weight. Nevertheless, the Examiner concludes that "the minor quantities of salt required by the prior art would reasonably fall within this range by inherency, or in the alternative it would have been obvious to one of ordinary skill in the art to perform the prior art processes wherein the minor quantities of salt are about 3%" (see Examiner's Answer, p. 6).

Inherency, however, requires more than the possibility that the cited art may fall within the claimed range. Indeed, the "fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Each of the cited prior art references are silent with respect to the amount of salt that may be present, except for the requirement that the salt be present only in minor quantities. Because such "minor quantities" may or **may not** fall within

the claimed range, the prior art simply cannot inherently teach the required claimed amount. Therefore, the rejection of the claims cannot be upheld on this basis.

As for the alternative argument that it would have been obvious to perform the prior art processes wherein the minor quantities of salt are about 3%, the Examiner does not provide any reasoning for such a conclusion. A conclusory statement without any articulated reasoning with some rational underpinning simply cannot support a conclusion of obviousness. See *KSR Intl. v. Teleflex Inc.*, 550 US ____ 82 USPQ2d 1385 (2007).

In fact, at the portions of the prior art cited by the Examiner, the prior art is completely silent with respect to the amount of catalyzing salt. Additionally, none of the Examples of the cited prior art discloses the use of any of NaCl, KCl, or LiCl and thus, the cited prior art is completely silent about amounts of these components. In the face of such silence, there is no rational underpinning, as required to support the rejection of the claims. Therefore, the rejection of the claims should be reversed.

B. Claims 9-11 are not properly rejected in view of WO 01/00530

In section (9) of the Examiner's Answer, claims 9-11 were identified as being rejected under 35 U.S.C. 103(a) as being unpatentable over Duyvesteyn (WO 01/00350). Curiously, claims 9-11 were not rejected in view of Duyvesteyn (US 6,440,383). It is curious because WO 01/00350 does not provide any additional disclosure beyond that of US 6,440,383 that would have led one of skill in the art to the conclusion put forth by the Examiner. Consequently, the proper conclusion is that WO

01/00350, like US 6,440,383, does **not** support a rejection of claims 9-11. Therefore, the rejection of these claims should be reversed.

C. A eutectic mixture is not the mere optimization of components

The specification of the subject application points out the unobvious results achieved by the use of a eutectic mixture of the claimed salts, NaCl, KCl, and LiCl. There is no suggestion in the cited art to choose two or more of the claimed salts and to further choose a eutectic mixture. In the absence of some articulated reasoning why one of skill in the art would make these selections, the conclusion that correctly choosing the appropriate salts **and** the appropriate eutectic mixture is simply mere optimization does not provide the required rational underpinning to support a conclusion of obviousness. Therefore, the rejection of claims 9-11 should be reversed.

D. Conclusion

In view of the above remarks, Appellants submit that the claimed invention is patentable in view of the cited references of record. Appellants therefore request the reversal of the rejections of all the claims.

Respectfully submitted,



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